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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,767	12/09/2003	John Frederick Porter	D1815-00060	4269

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,767

Applicant(s)

PORTER, JOHN FREDERICK

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's response filed October 24, 2006. In view of Applicant's terminal disclaimer, all previously set forth rejections have been overcome. However, an updated search was performed and additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein below.

Terminal Disclaimer

2. The terminal disclaimer filed on October 24, 2006, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/843257 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 11, 12, 14, 16, 21, 22, 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Todt (US 6,696,120). Todt discloses a material comprising a first nonwoven polyester fibrous web, a scrim made of PET threads (col 2, ln 30-42), and a film layer (col 3, ln 33-36 and Figure 3). The nonwoven fabric can be hydroentangled (col 2, ln 34). Regarding claims 21 and 22, it has been held that a recitation with respect to the manner in which a claim apparatus is intended to be

employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the limitations of a "roofing or siding material" or a "garment" have not been given any patentable weight.

5. Claims 11, 12, 13, 14, 16, 17, 20, 21, 22, 23, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Cordell (US 6,274,520). Cordell discloses a waterproof fabric comprising a five-ply laminate. One layer comprising a batting (i.e. nonwoven) made from rayon or polyester fibers, and mixtures thereof, wherein the fibers are punched into a nonwoven polyester scrim (col 3, ln 45-51). The layer next to the scrim layer can be a breathable film (col 3, ln 52-56). Another layer that is contiguous to the third layer can be identical in composition to the batting layer (nonwoven comprising rayon and polyester fibers, and mixtures thereof (col 4, ln 7-8 and ln 30-33). The layers are laminated together to each other quickly by ultrasonic energy to form an integral waterproof, breathable fabric (col 4, ln 16-17). Regarding claims 21 and 22, it has been held that a recitation with respect to the manner in which a claim apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the limitations of a "roofing or siding material" or a "garment" have not been given any patentable weight.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15, 19, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todt (US 6,696,120), as set forth above. Todt discloses the claimed invention except for the teaching that the composite has a weight of about 100-200 grams/square meter.

It has been held that weight is a result effective variable. The weight of the fabric directly affects the strength of the composite. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a composite having an areal weight of about 100-200 grams/square meter, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the basis weight of the composite motivated by the desire to obtain a composite that has increased strength and durability.

8. Claims 15, 19, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordell (US 6,274,520), as set forth above. Cordell discloses the claimed invention except for the teaching that the composite has a weight of about 100-200 grams/square meter.

It has been held that weight is a result effective variable. The weight of the fabric directly affects the strength of the composite. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a composite having an areal weight of about 100-200 grams/square meter, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617

F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the basis weight of the composite motivated by the desire to obtain a composite that has increased strength and durability.

9. Claims 24, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordell (US 6,274,520), as set forth above, in view of Brunka et al. (US 5,733,824). Cordell discloses the claimed invention except for the teaching that the scrim layer is coated.

Brunka et al. (US 5,733,824) disclose hand-tearable barrier laminates that include a reinforcing layer (abstract). The reinforcing layer can be a scrim made of polyester or rayon or combinations thereof (col 3, ln 56-59). PVC coating is applied and saturates the web (col 4, ln 14-31). Fire-resistant additives are added to the laminate (col 2, ln 19-20).

It also would have been obvious to have used the PVC coating and fire resistant additives of Brunka et al. in the fabric of Cordell, motivated by the desire to create a fabric having increased strength, water resistance, tear properties, weatherability, and fire resistance.

Claim Rejections - 35 USC § 102/103

10. Claim 18 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Todt (US 6,696,120).

Although, Todt et al. fail to explicitly teach the claimed water vapor permeability transmission, it is reasonable to presume that this property is inherent to the laminate of Todt. Support for said presumption is found in the use of like materials (i.e. nonwoven outer layer, inner polyester scrim, breathable film). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the present claimed properties of a water vapor

transmission rate of greater than 250 g/m²/day, would obviously have been present once the Todt product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

11. Claim 18 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cordell (US 6,274,520).

Although Cordell fail to explicitly teach the claimed water vapor permeability transmission, it is reasonable to presume that this property is inherent to the laminate of Cordell. Support for said presumption is found in the use of like materials (i.e. nonwoven outer layers, inner polyester scrim, breathable film). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the present claimed properties of a water vapor transmission rate of greater than 250 g/m²/day, would obviously have been present once the Cordell product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR

Wla Ruddock
Wla C. Ruddock
Primary Examiner
Tech Center 1700